

REMARKS

In response to the Examiner's Office Action of April 21, 2005, Applicants will herein respond with the following considerations.

Examiner has given a Final Rejection by suddenly coming up with another reference which is Bhat, U.S. Patent 5,668,995. This involves a method and apparatus for capacity planning for a multi-processor computer system in client/server environments.

The extant claims 1-6 have been rejected under 35 USC 102(b) as being anticipated by the Bhat, U.S. Patent 5,668,995.

Applicants would herein traverse such considerations provided by the Examiner on the basis that while the Bhat reference does have some considerable similarity, the Bhat reference does not show the specific type and implementation and problem-solving capability that is provided by Applicants' system and method. An immediate contrast should be made between Applicants' Fig. 1A, which shows a series of databases (server information database 20, sizing database 30, configuration database template 40, configuration session database 50), and which work in connection with an Application Delivery Solution Configurator 60 (indicated and referenced in USSN 09/813,670).

Contrast this with the Bhat Fig. 1, which only indicates a workstation 10 with operating system 22, capacity planning system 24, disk storage 14, keyboard 20, operating system 22, monitor 12, mouse device 18 which works in conjunction with a printer 16.

It should be obvious there is very little correlation between both the physical structural configuration of Applicants' system, compared to the structural arrangement of the Bhat system in Fig. 1.

Likewise, Bhat's Fig. 2 shows a series of steps useable in the Bhat system which are merely generalized, hopeful, promising statements of what should be done without any particular implementation as to exactly how such "hopeful promises" can be done.

This should be contrasted with Applicants' specific operations shown in Fig. 1B, Fig. 1C, and as applied to the configuration of Fig. 2, which shows a Metafarm 8 composed of a series of Server Farms 10A, 10B . . . 10K.

This is an unusually different format and configuration from the Bhat reference.

Bhat does not concern itself with the development of Server Metafarms, as are shown in Applicants' Fig. 2, and all the required information that will be involved using the databases of Applicants' Fig. 1A.

The Bhat reference is merely "suggesting and posing" a group of desirable activities to be done without any actual implementation of how these activities are to be done. Contrast this with Applicants' Figs. 1-28, which provides a specifically intimate set of actual details involved in developing information for an Application Solution Configurator (as indicated in USSN 09/813,668, Docket 041-512-L), which will provide an optimum configuration for multiple Server Farms which will satisfy the requirements of a user according to the input information supplied by a customer.

In regard to Examiner's citation of various Bhat statements as against specific clauses of Applicants' claims, the following legal decisions and precedents should be taken into account in regard to evaluation of Applicants' presently extant claims --- as indicated by the following legal precedents.

In Verdegai Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053, decided by the Federal Circuit in 1987 (and also with reference to MPEP 2131), the Court indicated that:

It is well established that "a claim is anticipated under 35 USC 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference".

Additionally, some further light is cast in the recent CAFC decision, Trintec Industries, Inc. v. Top-USA Corporation, as decided by the Court of Appeals, Federal Circuit, as follows:

"Inherent anticipation requires that the missing descriptive material is "necessarily present" not merely probably present or possibly present, in the prior art" quoting In re Robertson, 49 USPQ2d (1949,1950,1951), decided by the Federal Circuit.

It should further be indicated that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijakaert, 9 Fed.3d, 1531, 1534; 28 USPQ2d, 1955, 1957 (Fed.Cir. 1993). Here it was stated as follows:

In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d, 1461, 1464 (Board of Patent Appeals and Interferences, 1990). (Also see, MPEP 2112).

Further, the recent CAFC decision should be noted in Elan Pharmaceuticals v. Mayo Foundation For Medical Education And Research, 68 USPQ2d, 1373, (decided October 2, 2003, Court of Appeals, Federal Circuit), which held the following:

The disclosure in an anticipating reference must be adequate to enable the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation. (underlines added)

Now, in this regard, in view of the stated law decisions and precedents, Applicants would indicate to Examiner that the following indications and discussions will first show Applicants' claim, and then show a chart of each major claim clause, together with Applicants' citation from the Bhat reference. This will be done for claims 1, 2, 4 and 6.

Here, Applicants will now indicate how each particularly cited teaching of the Bhat reference does not cover the teaching of each of the Applicants' clauses involved --- so, in this regard, it will be seen that the Bhat reference cannot be considered anticipative of the extant claims indicated by Applicants.

We shall now turn to Applicants' claim 1 and the various clauses involved on which Examiner has cited certain portions of the Bhat reference.

IN THE DRAWINGS:

Formal drawings were previously supplied.